

PATENT  
512425-2101**REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

**I. STATUS OF CLAIMS AND FORMAL MATTERS**

The applicants thank the Examiner for the indication of allowable subject matter regarding claims 7-9 and 13 which should serve to expedite prosecution.

Claims 1-17 are pending in this application. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

**II. THE REJECTION UNDER 35 U.S.C. 102(e) HAS BEEN OVERCOME**

Claims 1-6, 10-12 and 14-17 were rejected by the Examiner as allegedly being anticipated by Aeby et al. (U.S. Patent 6,696,052 - "Aeby"). Reconsideration and withdrawal of the objections are requested for the following reasons.

MPEP 2131 states that "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909, 96 L. Ed. 2d 382, 107 S. Ct. 2490 (1987); *In re Coker*, 59 C.C.P.A. 1185, 463 F.2d 1344, 1348, 175 USPQ 26, 29 (CCPA 1972). However, the Aeby reference does not meet this standard.

The applicants' claim 1 is directed toward an oil-in-water emulsion which simultaneously contains each of the elements defined by A. - F. in claim 1. The Examiner points to Example B

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in col. 9 of Aeby as being anticipatory. However, as the table below shows, this assertion is incorrect.

Comparison of Claim 1 vs. Example B of Aeby		
	Claim 1	Example B of Aeby
	A cleaning and polishing oil-in-water emulsion which comprises:	???
A.	about 0.1 to about 25 % of at least one silicone oil with a viscosity ranging between about 20 and about 100,000 mPas.;	NO
		TMS-amodimethicone emulsion = 1% (see attachment for structure of amodimethicone; R = TMS)
B.	about 0.5 to about 25 % of at least one bisquaternary organomodified silicone of the formula: $[Z-M-(R'R'')SiO-[(R'R'')SiO]_n-Si(R'R'')-M-Z]^{2+} 2 X^- \quad (I)$ whereby Z is a quaternary nitrogen radical, R' and R'' are independently from each other an alkyl or an aryl radical, M is a divalent hydrocarbon radical having at least 4 carbon atoms which optionally contain at least one hydroxyl group and which may be interrupted by one or more oxygen atoms and/or groups of the type -C(O)-, -C(O)O- or -C(O)N-, n is a number between 1 and 200, X <sup>-</sup> is an inorganic or organic anion;	Quaternary organo-silicone (ABILQUAT® 3272) - a bisquaternary organomodified silicone = 1.5%
C.	about 0.1 to about 15.0 % of at least one nonionic or amphoteric surfactant which has an alkyl chain length between 6 and 14 carbon atoms;	NO
D.	about 1 to about 40 % of at least one oil selected from the group of mineral oils, paraffin oils, petroleum distillates, hydrocarbon solvents, ester oils, triglycerides and cyclic silicone oils;	Paraffin = 4% Isopropyl myristate = 2%
E.	about 0.1 to about 15 % of at least one emulsifier;	REWOTERIC® 50 = 1% Cetyltrimethyl ammonium chloride = 1.3% citric acid to achieve a pH = 4
F.	about 20 to about 99 % water;	less than 83.1% water (depending on amount of citric acid)
	optionally one or more auxiliaries selected from the group consisting of consistency enhancers, thickeners, stabilizers, fragrances, preservatives, antioxidants, dyes, abrasives, glycol ethers, alcohols, and builders.	Cetearyl alcohol = 6% Perfume = 0.1%

As can be seen from the above chart, the Aeby reference lacks a teaching for both elements A and C. Even if Aeby had taught elements A and C, Aeby's example does not

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explicitly teach that the composition is an oil-in-water emulsion; only that a component of their composition is an emulsion (TMS-amodimethicone emulsion). In addition, the Examiner is presuming that the applicants' invention contains citric acid and has a pH of 4.

If each of these elements are deemed to be inherent by the Examiner, then evidence must be provided in support of the claims for inherency (see MPEP 2112, sec. IV (Requirements of Rejection Based on Inherency; Burden of Proof) "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted)).

Accordingly, it is submitted that when one considers the text of the Aeby reference, one does not find the requisite elements of the applicants' claimed invention or that other elements claimed to be inherent properties have been proven by appropriate supporting evidence. Therefore, reconsideration and withdrawal of the Section 102 rejection is requested.

### **REQUEST FOR INTERVIEW**

In the interest of adhering to the tenets of compact prosecution and obtaining good customer service (see page 7 of the FY-2004 Performance and Accountability Report), the applicants request that the teachings of MPEP 707.07(j), sections II and III be applied, especially with regard to the offer of suggestion for correction by the Examiner if the rejections are upheld.

In accordance with MPEP 713.01, section III, should any issue remain as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested; and, the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview ("An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present in the office." *Id.*).

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In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By: Howard C. Lee

Howard C. Lee

Reg. No. 48,104

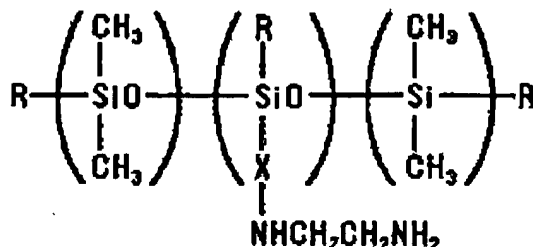
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Attachment: Monograph for Amodimethicone from *The International Cosmetic Ingredient Dictionary and Handbook*, (2001)

## AMODIMETHICONE

**Definition:** Amodimethicone is a siloxane polymer end blocked with amino functional groups. It conforms generally to the formula:



where R=OH or CH<sub>3</sub>, and X represents the propyl, isopropyl, or isobutyl group.

**Information Sources:** CIR: [S](1), JCIC, JCLS

**Chemical Classes:** Amines; Siloxanes and Silanes

**Functions:** Hair Conditioning Agent

**Reported Product Categories:** Hair Dyes and Colors (All Types Requiring Caution Statements and Patch Tests); Hair Conditioners; Permanent Waves; Hair Preparations (Non-coloring), Misc.; Tonics, Dressings, and Other Hair Grooming Aids; Hair Straighteners; Shampoos (Non-coloring); Hair Wave Sets; Hair Sprays (Aerosol Fixatives); Hair Coloring Preparations, Misc.

**Technical/Other Names:**

Aminoethylaminopropylsiloxane-Dimethylsiloxane Copolymer Emulsion

**Trade Names:**

Dow Corning 2-8566 Amino Fluid (Dow Corning)

Dow Corning Q2-8220 Conditioning Additive (Dow Corning)

KF880 (Advanced Polymer)

KF-8004 (Shin Etsu)

KF-867S (Shin Etsu)

Mirasil ADM (Rhodia)

Mirasil ADM - E (Rhodia HPCII)

SF1708 (GE Silicones)

Silicone Fluid F-801 (Wacker Silicones)

Silsoft 331 (OSi Specialties)

Silsoft A-817 (OSi Specialties)

Silsoft A-887 (OSi Specialties)

SM2059 (GE Silicones)

TP-515 (OSi Specialties)

Wacker Belsil ADM 652 (Wacker-Chemie)

Wacker - Belsil ADM 656 (Wacker-Chemie)

Wacker - Belsil ADM 1100 (Wacker-Chemie)

Wacker - Belsil ADM 1600 (Wacker-Chemie)

Wacker - Belsil ADM 1650 (Wacker-Chemie)

**Trade Name Mixtures:**

AEC Amodimethicone & C11-16 Pareth-7 & C12-16 Pareth-9 & Glycerin & Trideceth-12(2) (A & E Connock)

AEC Amodimethicone (&) Trideceth-12 & Cetrimonium Chloride(3) (A & E Connock)

Dow Corning 929 Cationic Emulsion(4) (Dow Corning)

Dow Corning 949 Cationic Emulsion(5) (Dow Corning)

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Dow Corning 7224 Conditioning Agent(6) (Dow Corning)  
Dow Corning 2-8177 Emulsion(7) (Dow Corning)  
Dow Corning 939 Emulsion(8) (Dow Corning)  
Dow Corning 9224 Emulsion(9) (Dow Corning)  
Dow Corning (R) 2-8194 Microemulsion(10) (Dow Corning)  
SM2101(11) (GE Silicones)  
SM2115(12) (GE Silicones)  
SM2125(13) (GE Silicones)  
SME253(14) (GE Silicones)  
Wacker Belsil ADM 6057 E(15) (Wacker-Chemie)

**International Cosmetic Ingredient Dictionary and Handbook, 9th Edition, Printed Edition Page Number: 107**

**Cross References:** International Buyers' Guide(16) and Cosmetic Ingredient Review(17). These hypertext links will activate when associated electronic books are purchased.